

DOCKET NO.: FCI-2699/4450G

PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Gerrits et al.

Confirmation No.: 9222

Application No.: 09/916,491

Group Art Unit: 2876

Filing Date: July 27, 2001

Examiner: Diane I. Lee

For: Electronic Card Assembly and Shell Therefor

DATE OF DEPOSIT: June 23, 2004

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TYPED NAME: Vincent J. Roccia
REGISTRATION NO.: 43,887

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**RENEWED PETITION TO ACCEPT UNINTENTIONALLY DELAYED
CLAIM FOR PRIORITY PURSUANT TO 37 CFR §1.78(a)(3)**

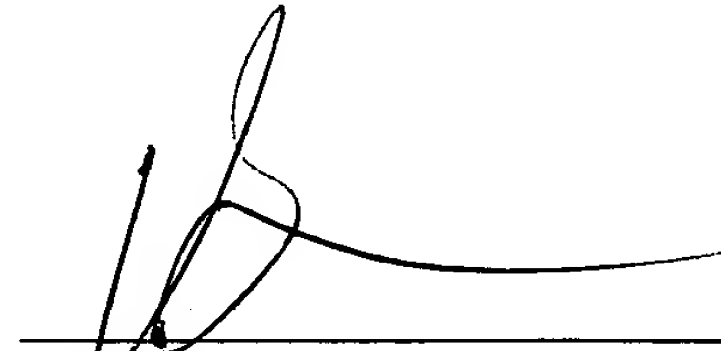
On March 4, 2004, Applicants submitted a Petition to Accept Unintentionally Delayed Claim for Priority Pursuant to 37 CFR 1.78 (a)(3). Applicants' petition was subsequently dismissed in a decision by the Office of Petitions dated May 5, 2004 (copy enclosed). The decision stated that Applicants' amendment failed to make a reference to the first (earliest) application and every application after the first application and before such intermediate application. The decision further indicated that submission of a substitute amendment, along with a renewed petition under 37 CFR 178(a)(3), would place the petition in position to be granted.

Accordingly, Applicants submit herewith a revised amendment claiming priority under 35 U.S.C. §120 to PCT/US97/14369 filed August 13, 1997, which claims benefit to the previously noted provisional application.

In light of the foregoing submission, Applicants believe their petition and amendment now meets all of the requirements of 37 CFR 1.78(a) and respectfully request reconsideration and grant thereof.

As the petition fee has already been paid, no further fee is believed to be due. However, should a fee in fact be due, the Commission is hereby authorized to charge payment of the any fee associated with this communication to Deposit Account No. 23-3050. This petition is submitted in duplicate.

Date: June 23, 2004

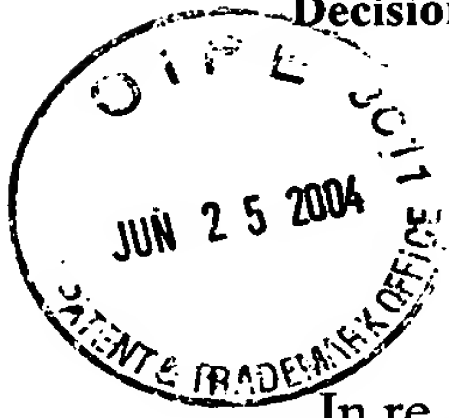


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DOCKET NO.: FCI-2699/4450G
Application No.: 09/916,491
Decision on Petition Dated: May 5, 2004

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Gerrits et al.

Confirmation No.: **9222**

Application No.: **09/916,491**

Group Art Unit: **2876**

Filing Date: **July 27, 2001**

Examiner: **Diane I. Lee**

For: **Electronic Card Assembly and Shell Therefor**

DATE OF DEPOSIT: June 23, 2004

I HEREBY CERTIFY THAT THIS PAPER IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL, POSTAGE PREPAID, ON THE DATE INDICATED ABOVE AND IS ADDRESSED TO THE COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450.

TYPED NAME: Vincent J. Roccia
REGISTRATION NO.: 43,887

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY PURSUANT TO 37 CFR § 1.111

In response to the Decision on Petition dated **May 5, 2004**, reconsideration is respectfully requested in view of the amendments and/or remarks as indicated below:

- ☒ **Amendments to the Specification** begin on page 2 of this paper.
- ☐ **Amendments to the Claims** are reflected in the listing of the claims which begins on page of this paper.
- ☐ **Amendments to the Drawings** begin on page of this paper and include an attached replacement sheet.
- ☒ **Remarks** begin on page 3 of this paper.

DOCKET NO.: FCI-2699/4450G
Application No.: 09/916,491
Decision on Petition Dated: May 5, 2004

PATENT

Amendments to the Specification:

Please amend the continuity information on page 1, line 2 as follows:

This application is a continuation of United States Application application Serial Number 09/297,776 filed 28-July 28, 1999 (herein incorporated by reference), ~~which is a continuation of application Serial Number 08/748,503 file 08 November 1996, now US Patent 6058018 on 02 May 2000. This application also priority from Provisional Application 60/047,398 filed 22 May 1997~~ which is the United States National Phase of International Application No. PCT/US97/14369, filed August 13, 1997, both of which claim benefit of United States Provisional Application No. 60/047,398 (herein incorporated by reference), filed May 22, 1997. This application is a continuation of the parent application, United States Application No. 09/297,776, which also is a continuation of Application Serial Number 08/748,503, filed November 8, 1996, which issued as United States Patent 6,058,018 on May 2, 2000 (herein incorporated by reference).

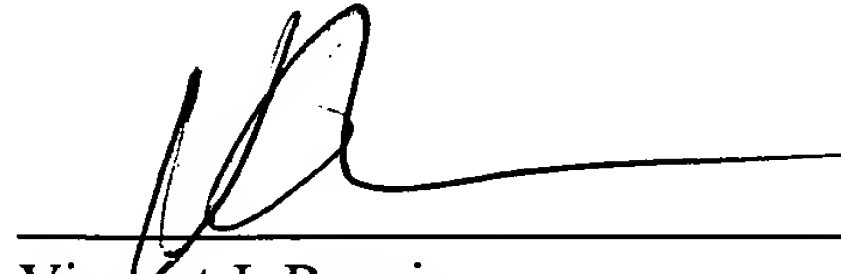
DOCKET NO.: FCI-2699/4450G
Application No.: 09/916,491
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PATENT

REMARKS

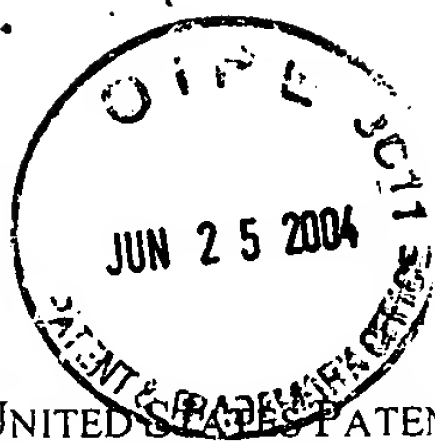
The amendment to the specification herein reflects the current claim of priority.

Date: June 23, 2004



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In re Application of
Antonius H.J. Gerrits et al
Application No. 09/916,491
Filed: July 27, 2001
Attorney Docket No. FCI-2699/4450G

: OFFICE OF PETITIONS
:
: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)
:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed March 4, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional application (Application No. 09/748,503) set forth in the amendment filed November 25, 2002, and resubmitted with the instant petition.¹

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1) above. In this regard, the amendment, as currently worded, cannot be entered as filed since provisional Application No. 60/047,398 was filed more than one year from the instant prior-filed application, to priority is being claimed. It is

¹ The instant application was published on May 9, 2002 and contained a reference to nonprovisional Application No. 09/297,776 and provisional Application No. 60/047,398.

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Application No. 09/916,491

Page 2

noted that intermediate Application No. 09/297,776 is a 371 of PCT/US97/14369, filed August 13, 1997, which claims benefit to the above-noted provisional application. Where an application claims a benefit under 35 U.S.C. 120 of a chain of applications, the application must make a reference to the first (earliest) application and every intermediate application. *See Sampson v. Ampex Corp.*, 463 F.2d 1042, 1044-45, 174 USPQ 417, 418-19 (2d Cir. 1972); *Sticker Indus. Supply Corp. v. Blaw-Knox Co.*, 405 F.2d 90, 93, 160 USPQ 177, 179 (7th Cir. 1968); *Hovlid v. Asari*, 305 F.2d 747, 751, 134 USPQ 162, 165 (9th Cir. 1962). *See also* MPEP § 201.11. Every intermediate application must make a reference to the first (earliest) application and every application after the first application and before such intermediate application. Therefore, if appropriate, a reference to the PCT application in the amendment should be made in order to claim benefit of the above-noted provisional application.

If reconsideration of this decision is desired, a renewed petition under 37 CFR 1.78(a)(3), along with a substitute amendment correcting the above-noted deficiency, must be submitted, along with a renewed petition under 37 CFR 1.78(a)(3).

Further correspondence with respect to this matter should be addressed as follows:

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 Commissioner for Patents
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 Alexandria, VA 22313-1450

By hand: Customer Window located at:

 2011 South Clark Place
 Crystal Plaza Two Lobby
 Room 1B03
 Arlington, VA 22202

By fax: (703) 872-9306
 ATTN: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-8680.


Frances Hicks

Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy